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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,250	07/05/2006	Ferdinand Mannle	061778.002	2992

7590 08/18/2010
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Houston, TX 77208-1389

EXAMINER

MULCAHY, PETER D

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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08/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/554,250	Applicant(s) MANNLE ET AL.	
	Examiner Peter D. Mulcahy	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of aqueous hydrogen peroxide oxidizing agent in the reply filed on 5/28/10 is acknowledged. The traversal is on the ground(s) that "A person of skill in the art understands what an oxidizing agent is, and how the oxidizing agent works. Furthermore, one of skill in the art understands that the selection of an oxidizing agent is dependent upon the specific situation that is presented to the skilled artisan."

Claims 2-4 are directed to species of oxidizing agent. While applicant has not indicated that these species are obvious variants, it is stated on record that oxidizing agents are well understood. The election of species is herein held in abeyance understanding the art recognized function and properties of the claimed species of oxidizing agents. Should applicant allege that the species are patentably distinct then the election of species requirement is proper given the lack of unity between patentably distinct species.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boberg et al US 3,865,767 or Hwu et al US 5,434,277.

The rejection set forth under 35 USC 103 in the paper mailed 3/31/09 over Boberg is deemed proper and is herein repeated.

The newly amended claims and remarks filed in support thereof have been fully considered but have been found not persuasive.

Specifically it is argued that the art fails to recognize using the metal salt in highest stable oxidization state and using an oxidizing agent to ensure the metal salt remain in the highest oxidization state. This is not persuasive. The claimed oxidizing agents (peroxides and hydroperoxides) are present in the photolysis reaction, see column 4 lines 65+. The highest oxidization state is inherently ensured by the presence of the peroxides during the photolysis reaction. The fact the art does not mention the specific incorporation of oxidizing agents or the purpose of metal salt in the highest oxidization state is not germane to the patentability. The oxidizing agent (peroxide) is present and the oxidization state of the metal is thereby ensured.

The Hwu patent teaches forming metal salts used in degrading plastics. The metal salts are prepared using sodium hydroxide and stearic acid, see column 4 lines 64+. The "complete saponification" of the acid followed by the reaction with the ferric chloride is seen to result in the salt being formed in the highest oxidization state. The sodium hydroxide is seen to anticipate the claimed "oxidizing agent." This example would appear to anticipate the claimed limitations. The species of oxidizing agents are seen to be obvious variants of the "oxides or hydroxides" referenced at column 1 lines 49-51. These compounds would ensure the highest oxidization state of the metal salt as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796